Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORAN LUKIC

Appeal No. 1999-0253
Application No. 08/636,206

ON BRIEF

Before GARRIS, WALTZ, and SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 15 through 17 and 20 through 22 as amended subsequent to the final rejection (see the amendments dated Mar. 9, 1998, Paper No. 10, and May 6, 1998, Paper No. 13, entered as per the Advisory Actions dated Apr. 3, 1998, Paper No. 11, and May 20, 1998, Paper No. 15). Claims 15-17 and 20-22 are the only claims remaining in this application.

According to appellant, the invention is directed to methods of applying a polymeric cover to a stent (Brief, page 1). A copy of representative claim 15 is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Kaster	4,441,215	Apr. 10, 1984
MacGregor	5,015,253	May 14, 1991
Gianturco (filed June 15, 1992)	5,282,824	Feb. 1, 1994
Simon et al. (Simon) (filed May 1, 1992)	5,354,308	Oct. 11, 1994

The claims on appeal stand rejected under the first paragraph of 35 U.S.C. § 112 "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention," i.e., failure to fulfill the written description requirement[1] (Answer, page 4). The claims on appeal also stand rejected under 35 U.S.C. § 103 as unpatentable over MacGregor in view of Gianturco and Kaster, optionally further in view of Simon (Answer, page 5). We *reverse* the examiner's rejections for reasons which follow.

[1] *See Vas-Cath Inc. v. Mahurkar,* 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991).

OPINION

A. The Rejection under Section 112, ¶1

The examiner finds that the original specification supports allowing the stent to radially expand but finds no support for the claimed alternative of "radially expanding at least the portion of the stent in the tube" (Answer, page 4). In other words, the claims on appeal recite both active and passive steps of radially expanding the stent while the examiner asserts that the original specification fails to reasonably convey these two different types of expansion to one of ordinary skill in the art (Answer, pages 11-12). We disagree.

As correctly argued by appellants (Brief, pages 3-4; Reply Brief, pages 1-2), the original specification teaches that the invention is not limited to the embodiment shown but is "applicable to any kind of expandable stent having a discontinuous wall." Specification, page 5, ll. 2-5. Appellants assert that active sense expandable stents were well known in the art as of the original filing date and the examiner has not contested this assertion (Answer, page 12).[2]

[2] As an example of active sense expanding stents, see the prior art discussed by MacGregor at col. 2, ll. 24-50.

Ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. The disclosure need only reasonably convey to persons skilled in the relevant art that the inventor had possession of the subject matter in question. *See In re Edwards,* 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The examiner has not met the initial burden of proof by failing to provide reasons why one of ordinary skill in the stent art would not consider the description (at page 5, ll. 2-5, of the specification) in addition to the knowledge in the art that active sense expandable stents were conventional sufficient to reasonably convey that appellant was in possession of the subject matter in question. *See In re Alton,* 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

For the foregoing reasons, the rejection of the claims on appeal under the first paragraph of 35 U.S.C. § 112 is reversed.

B. The Rejection under 35 U.S.C. § 103

The examiner acknowledges that Gianturco, the secondary reference employed by the examiner to teach the use of an elastomeric sleeve or covering for stents, is silent as to how the stent is fitted within the tubular preformed sleeve (Answer, page 8). Nonetheless, the examiner concludes that "one of ordinary skill in the art would have readily understood that *some*

technique was used to position the stent of Gianturco within the preformed tubular sleeve" and thus would have used the stent insertion technique taught by MacGregor for deployment of a stent in a catheter (Answer, pages 8-9, emphasis added). However, the examiner has not identified any support in Gianturco for the finding that the sleeve is "preformed" or any reason or suggestion for the combination of the references as proposed.

Evidence of a suggestion, teaching, or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *See In re Dembiczak,* 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The examiner has not identified any convincing, clear evidence of a reason, teaching or motivation to adapt the catheter deployment technique of MacGregor to a method of forming the covered stent of Gianturco. It is noted that the deployment method of MacGregor requires release of the stent from the catheter while the claims on appeal require "chemically bonding at least the portion of the stent and the tube together." See claim 15 on appeal and MacGregor, col. 2, ll. 1-4. It is also noted that the examiner has not identified any portion of Gianturco that discloses or suggests that the sleeve or tube is "preformed." The examiner's own

reference to Kaster discloses formation of the sleeve or covering tube by a method other than insertion of the stent into a preformed tube, i.e., by deposition of liquid plastic material on the stent (col. 4, ll. 1-8; col. 7, ll. 12-25). Accordingly, we determine that the examiner has not identified any reason, teaching, or motivation from the references themselves, the nature of any known problem, or the knowledge of the prior art, that would support the proposed combination of references. Kaster, as discussed above, and Simon have been applied to show additional features of the claimed subject matter and do not remedy the deficiency noted above.

For the foregoing reasons, we determine that the examiner has not presented a case of *prima facie* obviousness in view of the reference evidence. Accordingly, the rejection of the claims on appeal under section 103 over MacGregor in view of Gianturco and Kaster, optionally further in view of Simon, cannot be sustained.

C. Summary

The rejection of claims 15-17 and 20-22 under 35 U.S.C. § 112, ¶1, is reversed. The rejection of claims 15-17 and 20-22

under 35 U.S.C. § 103 over MacGregor in view of Gianturco and Kaster, optionally further in view of Simon, is reversed.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)
Administrative Patent Judge)
)
)
)
THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)
)
JEFFREY T. SMITH)
Administrative Patent Judge)

jg

Appeal No. 1999-0253
Application No. 08/636,206

SCIMED LIFE SYSTEMS, INC.
ONE SCIMED PLACE, M.S. A150
MAPLE GROVE, MN 55311-1566

APPENDIX

15. A method for applying a covering layer to a stent comprising:

(a) forming a tube made out of an elastomeric polymerisable composition;

(b) radially contracting the stent;

(c) inserting into the tube at least a portion of the stent; and

(d) radially expanding at least the portion of the stent in the tube or allowing at least the portion of the stent to expand in the tube, and chemically bonding at least the portion of the stent and the tube together.